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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/811,648	03/05/1997	DAN KIKINIS	P1523CIP	1380

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EXAMINER

VAUGHN JR, WILLIAM C

ART UNIT	PAPER NUMBER
2142	31

DATE MAILED: 03/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	08/811,648	KIKINIS, DAN
	Examiner	Art Unit
	William C. Vaughn, Jr.	2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 16 January 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-4,7-9 and 13-17 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-4,7-9 and 13-17 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. This Action is in response to the Request for Reconsideration received 16 January 2003.
2. Paper 30, received 16 January 2003 has been entered into record.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 January 2003 has been entered.

4. The application has been examined. **Claims 1-4, 7-9 and 13-17** are pending. The objections and rejections cited are as stated below:

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. **Claims 1-4, 7-9 and 13-17** are rejected under 35 U.S.C. 102(e) as being anticipated by Goodman, U.S. Patent No. 5,844,596.

7. Regarding **claim 1**, Goodman discloses a networking system for a home or business site [see Goodman, Abstract, Col. 3, lines 1-56], comprising: a bridge adapter [see Goodman, item 400] unit having an inlet port for receiving public network protocol signals [see Goodman, Col. 8, lines 9-10]; and a telephone wiring structure in the site, the wiring structure having multiple end points and one or more junctions [see Goodman, Col. 8, lines 1-25], and connected at a single point to an outlet port of the bridge adapter unit; characterized in that the bridge adapter unit drives the telephone wiring structure according to a Local Area Network (LAN) protocol, translates the public network protocol signals to the LAN protocol, and modulates the signals in a manner to correct signal variations at the end points due to having multiple end points driven from a single point at the bridge adapter unit, (see Applicant's specification on page 9, that is being used as a guide in interpreting this particular limitation), [see Goodman, Col. 9, lines 12-25, Col. 24, lines 8-16, Col. 31, lines 26-30, Col. 60, lines 15-29, Col. 67, lines 30-57]. By this rationale **claim 1** is rejected.

8. Regarding **claim 2**, Goodman further discloses one or more converters [see Goodman, item 452] connected at individual ones of the end points, the one or more converters comprising each an outlet port to connect to a single-media or a multimedia device, the converters converting the LAN signals to a form required by the single-media or multi-media device (Goodman teaches converters that convert signals from voice-band and transmits them through filters to local network where they communicate with the telephone device), [see Goodman, Col.

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4, lines 60-67, Col. 5, lines 1-15, Col. 11, lines 65-67, Col. 12, lines 1-8 and Col. 54, lines 56-67]. By this rationale **claim 2** is rejected.

9. Regarding **claim 3**, Goodman further discloses *one or more single-media or multi-media devices connected to one or more of the converters* [see rejection of claim 2, *supra*]. By this rationale **claim 3** is rejected.

10. Regarding **claim 13**, Goodman further discloses *individual ones of the converters are integrated into individual ones of the single-media or multi-media devices* [see Goodman, Col. 15, lines 16-60]. By this rationale **claim 13** is rejected.

11. Regarding **claim 14**, Goodman further discloses *wherein individual ones of the converters are internal modules of individual ones of the single-media or multimedia devices* [see Goodman, Col. 15, lines 16-60]. By this rationale **claim 14** is rejected.

12. Regarding **claim 4**, Goodman further discloses wherein the single-media and multi-media electronic devices include one or more of telephones, personal computers (item 495c), fax machines (well known), and televisions running through set top boxes [see Goodman, Figure 15, Col. 9, lines 47-54]. By this rationale **claim 4** is rejected.

13. **Claim 7** list all the same elements of **claim 1**, but in method form rather system form. Therefore, the supporting rationale of the rejection to **claim 1**, applies equally as well to **claim 7**. Furthermore, with regards to the steps of delivering [see Goodman, Col. 11, lines 1-18], installing [see Goodman, Col. 11, lines 34-49], connecting [see Goodman, Col. 11, lines 42-45], driving the telephone wire [see Goodman, Col. 12, lines 45-54], and modulating the signals [see Goodman, Col. 24, lines 8-16]. By this rationale **claim 7** is rejected.

14. **Claim 8** list all the same elements of **claim 2**, but in method form rather system form. Therefore, the supporting rationale of the rejection to **claim 2**, applies equally as well to **claim 8**. By this rationale **claim 8** is rejected.

15. **Claim 9** list all the same elements of **claim 4** but in method form rather system form. Therefore, the supporting rationale of the rejection to **claim 4**, applies equally as well to **claim 9**.

16. Regarding **claim 15**, Goodman further discloses *wherein individual ones of the converters are integrated into individual ones of the single-media or multi-media devices* [see rejection of claim 13, supra]. By this rationale **claim 15** is rejected.

17. Regarding **claim 16**, Goodman further discloses *wherein individual ones of the converters are integrated into individual ones of the single-media or multi-media devices* [see rejection of claim 8, supra]. By this rationale **claim 16** is rejected.

18. Regarding **claim 17**, Goodman further discloses *wherein individual ones of the converters are internal modules in individual ones of the single-media or multi-media devices* [see rejection of claim 14, supra]. By this rationale **claim 17** is rejected.

Double Patenting

19. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20. **Claims 1, 2 and 7** are rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6,167,120 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Serial No. 08/811,648 teaches in claim 1:

A networking system for a home or business site, comprising:

U.S. Patent No. 6,167,120 teaches in claim 1:

A home networking system comprising:

Serial No. 08/811,648 teaches in claim 1:

A bridge adapter unit having an inlet port for receiving public networking protocol signals:

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U.S. Patent No. 6,167,120 teaches in claim 1:

A customer demarcation unit at a customer's premise, having a port connected to outside telephone wiring and a port connected to outside telephone wiring and a port connected to the conventional telephone wiring in the customer's premise, receiving signals on the outside telephone wiring,

Serial No. 08/811,648 teaches in claim 1:

A telephone wiring structure in the site, the wiring structure having multiple end points and one or more junctions, and connected at a single point to an outlet port of the bridge adapter unit:

U.S. Patent No. 6,167,120 teaches in claim 1:

Conventional telephone wiring connected to telephone jacks in a customer's premises:

Serial No. 08/811,648 teaches in claim 1:

Characterized in that the bridge adapter unit drives the telephone wiring structure according to a Local Area Network (LAN) protocol, and translates the public network protocol signals to the LAN protocol, modulates the signals in a manner to correct signal variations at the end points due to having multiple end points driven from a single point at the bridge adapter unit.

U.S. Patent No. 6,167,120 teaches in claim 1:

Driving the conventional telephone wiring in the customer's premises as a local-area (LAN) using a spectrum high frequency signal, converting the signals received to the protocol required by the LAN.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Response to Arguments

21. Applicant's request for reconsideration as well as arguments filed on 16 January 2003, have been carefully considered but they are not deemed fully persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address applicants' main points of contention.

- a. Applicant argues that Goodman does not disclose a bridge adapter unit driving the telephone wiring structure according to a LAN protocol.
- b. Applicant also contends that Goodman does not disclose translating the public protocol signals to the LAN protocol, or modulating the signals in a manner to correct signal variations at the end points due to having multiple end points driven from a single point at the bridge adapter.
- c. Applicant also argues that the "LAN protocol, namely micro-PBX, used for driving the LAN, micro-PBX being a converter and bus management system adapted to received ATM data for all of the devices to which the micro-PBX is connected, and to route the data in a different protocol onto the internal bus and that the micro-PBX operates the in-house wiring as a bus system under a multiple access point type protocol, such as Carrier Sense Multi Access/Collision Detect (CSMA/CD) protocol."
- d. Applicant states that the invention of Applicant teaches that the converters are converting signals from the Ethernet LAN protocol to a form required by the single media or multimedia device.

22. As to "Point a", it is the Examiner's position that a bridge adapter unit [see Goodman, item 400] *having an inlet port for receiving public network protocol signals* [see Goodman, Col.

8, lines 9-10]; *and a telephone wiring structure in the site, the wiring structure having multiple end points and one or more junctions* [see Goodman, Col. 8, lines 1-25] is taught. It is undeniable that the Goodman system provided the functionality by expressly disclosing a bridge adapter that drives individual telephoning within a LAN protocol as well as disclosing having multiple endpoints and one or more junctions [see also Goodman, Figure 1A, item 405n, Col. 10, lines 65-67, Col. 11, lines 1-5]. It is also that Examiner's position that the bridge adapter unit does in fact teach a system in which the transceiver/switch processes signals (*network protocol signals*) on different selected wire pairs leading to the local network [see also Goodman, Col. 11, lines 45-55]. These signals, also convert those signals to which protocol that is being used by the local area networks [see Goodman, Col. 13, lines 5-42, Col. 15, lines 4-12, Col. 30, lines 37-63].

23. As to "Point b", it is again the position of the Examiner that the argued features by Applicant are taught within the cited areas of Goodman [see Goodman, Col. 9, lines 12-25, Col. 24, lines 8-16, Col. 31, lines 26-30, Col. 60, lines 15-29, Col. 67, lines 30-57]. Goodman expressly teaches signal modulation to correct signal variations at the end points due to having multiple end points driven from a single point at the bridge adapter (Goodman teaches modulation as well as demodulation of signals and the primary reason for signal modulation is to blend different data signals (voice, text, etc.,) into a carrier for transmission over a network. The most common methods are (1) amplitude modulation (AM), which modulates the height of the carrier wave, (2) frequency modulation (FM), which modulates the frequency of the wave, and (3) phase modulation (PM), which modulates the polarity of the wave), [see Goodman, Col. 31, lines 26-36, Col. 38, lines 57-60]. All which are taught within Goodman. It is also the position of the Examiner that Goodman's teachings clearly show an adapter that converts signals

transmitted to the local network interface as well as the teachings of LAN (i.e., phone, TV, phone, computer). This particular feature is obvious to one of ordinary skill in the networking art for the converting of signals received within a LAN.

24. In response to Point c, of applicant's argument regarding that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., namely micro-PBX, used for driving the LAN, micro-PBX being a converter and bus management system adapted to received ATM data for all of the devices to which the micro-PBX is connected, and to route the data in a different protocol onto the internal bus and that the micro-PBX operates the in-house wiring as a bus system under a multiple access point type protocol, such as Carrier Sense Multi Access/Collision Detect (CSMA/CD) protocol) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

25. As to "Point D", the Applicant states that the converters are converting signals from the Ethernet LAN protocol to a form required by the single media or multimedia device. Goodman further teaches that one of the functions of the processor (418) is to select and recover video and **other types of signals** (i.e., computer, fax, TV, camera), change (convert) the characteristics of the recovered signals through processing apply the for transmission to the local networks [Col. 30, lines 35-64]. Further, Goodman teaches the all modulation and demodulation takes place within the processing unit [Col. 30, lines 54-67].

Terminal Disclaimer

26. Again, the disclaimer fee of \$55 in accordance with 37 CFR 1.20(d) has not been submitted, nor is there any authorization in the application file to charge a specified Deposit Account or credit card.

Conclusion

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (703) 306-9129. The examiner can normally be reached on 8:00-5:00, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Powell can be reached on (703) 305-9703. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.

WCV
Patent Examiner
Art Unit 2142
March 6, 2003

Mark R. Powell

MARK R. POWELL
SUPERVISORY PATENT EXAMINER
GROUP 2400